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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,481	08/13/1999	TOHRU FUSHIKI	35859.1	4398

7590

12/03/2001

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EXAMINER

COE, SUSAN D

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/367,481

Applicant(s)

FUSHIKI ET AL.

Examiner

Art Unit

Susan Coe

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 May 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached "Supplement to Advisory Action".
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 24-39.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14.
11. ☐ Other:

**Supplement to Advisory Action**

1. The text of those section of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. All of applicant's arguments regarding the 103(a) rejection of record have been fully considered but are not persuasive. Applicant argues that the teaching of Dohm would show a person of ordinary skill in the art that McCarty's hypothesis regarding HCA increasing endurance during exercise is incorrect. Applicant's assert that Dohm shows that a different mechanism than the mechanism purposed by McCarty increases endurance. The examiner disagrees. Dohm teaches that rats that have fasted for 24 hours show increased endurance. This conclusion flies in the face of common sense and practical experience. A person of ordinary skill in the art would be more likely to disregard the findings of Dohm than the conclusions of McCarty for these reasons. In addition to the practicality of Dohm's conclusions, Dohm does not evaluate the effectiveness of HCA. Without mention of HCA, there would be no clear reason for a person of ordinary skill in the art to look to Dohm when investigating the conclusions of McCarty.

Applicants also argue that Brunengraber shows that McCarty's hypothesis is incorrect. However, Brunengraber does not draw any clear conclusions regarding the relationship between HCA and exercise that would led a person of ordinary skill in the art to disregard McCarty's hypothesis.

The declaration of Dr. Fushiki reiterates these arguments made by applicant.

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In conclusion, the rejection of the claims is considered valid. In this rejection, McCarty stands on its own merits. McCarty gives detailed and clear reasoning why HCA would increase endurance. Based on this clear teaching by McCarty, a person of ordinary skill in the art would have had a reasonable expectation that using HCA to increase endurance would be successful. The references selected by applicant to dispute the conclusions of McCarty are inconclusive and not entirely applicable to the conclusions drawn by McCarty. The references would not lead a person of ordinary skill in the art to disregard the teaching of McCarty.

3. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 7:30 to 5:00 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC  
June 26, 2001



FRANCISCO PRATS  
PRIMARY EXAMINER